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EXAMINER

THOMSON, MICHELLE R

ART UNIT PAPER NUMBER

3641

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/731,684

**Applicant(s)**

VASEL ET AL.

**Examiner**

Michelle (Shelley) Thomson

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 1/6/05 have been fully considered but they are not persuasive and are moot in view of the new ground(s) of rejection as necessitated by applicant's amendments. It is noted that applicant has not set forth any arguments concerning the applicability of the prior art to the preamended claims and that applicant merely argues that the rejections of the prior action are not applicable because they do not contain elements which applicant has added in the current amendment. Applicant's acquiescence is noted concerning the application of the prior art to applicant's claimed invention prior to the current amendments.
2. With respect to applicant's arguments concerning the Tougeron et al. reference and the stabilizers, it is noted that amended claim 16 of the current application claims *additional stabilizers*, along with stabilizing fins. It is further noted that by the language of the claim the additional stabilizers are not required to be fins and/or any additional fins (more than two, which would meet the limitation of the plurality of *stabilizing fins*) would meet the limitation of *additional stabilizers*. In essence anything that provides stabilization would meet the limitation and the braking surface of Trougeron et al., which provides an equal surface around the entire projectile, would provide stabilization to the projectile.
3. With respect to applicant's arguments concerning the § 112 rejections and the objections to the specification, it is noted that while the specification of the current application may **implicitly** set out *means for launching the plurality of projectiles* and specifically *means for launching launches at least a sub-set of the plurality of the projectiles within a limited time*, it does not **explicitly** state, with reference to the terms and phrases of the claim element, what

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structure, materials, or acts perform the function recited in the claim elements and equivalents thereof. (See MPEP 2181). Applicant has merely implicitly recited a few examples of launchers for launching the projectiles in the specification, but upon attempting to claim a specific *means for launching the plurality of projectiles* one of ordinary skill in the art would not be apprised of what is included or excluded from the claim language. From the few examples of the specification, would further means including throwing the projectiles? And what is encompassed by the claims concerning “and/or and other similar rapid fire devices”? And what specifically are the *sub-set* and the *limited time*? Applicant has not even stated what the sub-set or limited time is in order to enable one of ordinary skill in the art to make the invention commensurate in scope with the **claims**.

### *Specification*

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Where the written description only implicitly or inherently sets forth the structure, materials, or acts corresponding to a means-plus-function, applicant must clarify the disclosure to **explicitly state, with reference to the terms and phrases of the claim element, what structure, materials, or acts perform the function recited in the claim elements and equivalents thereof.** (See MPEP 2181).

Correction of the following is required: applicant must clarify the disclosure to explicitly state, with reference to the terms and phrases of the claim element, what structure, materials, or acts perform the means for launching the plurality of projectiles recited in the claim elements and equivalents thereof.

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5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 22-25 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a system wherein a cartridge includes means comprising a projection cartridge to launch the projectile, does not reasonably provide enablement for a means for launching the plurality of projectiles and specifically wherein the means for launching launches at least a sub-set of the plurality of the projectiles within a limited time to contact a target along a path across the target. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 16 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Knapp (US Patent # 4,448,106). Knapp discloses a projectile system for use in delivering a substance to a

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target, comprising a projectile comprising a first part that is generally non-frangible nose section (reference 25), a second part that is at least partially hollow (reference 50), wherein the second part is secured with the first part to seal the hollow portion defining a volume, wherein the projectile is non-spherical, an inhibiting substance contained within the volume and stabilizing fins (reference 26, 2 of 4) secured with the second part along an exterior of the second part and additional stabilizers (reference 26, other 2 of 4) positioned on the exterior of the second part.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 13-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vassel et al. (US Patent # 6,543,365) and Carbone (US Patent # 5,361,700). Vassel et al. discloses the claimed projectile system for use in delivering a substance to a target comprising a projectile comprising a first part, a second part that is at least partially hollow wherein the second part is secured with the first part to seal the hollow portion defining a volume, wherein the projectile is non-spherical (Figures 16-19); an inhibiting substance (reference 1704) contained within the volume; stabilizing fins (reference 1802) (figure 20A shows at least 4 fins, 2 stabilizing fins and 2 additional stabilizers) secured with the second part along an exterior of the second part; wherein the inhibiting substance is dispersed into a cloud upon impact of the projectile with a target (Figures 23 and 24). Wherein the first part is at least partially hollow where the hollow portion of the first part cooperates with the hollow portion of the second part defining a volume

such that the inhibiting substance is contained within the volume (Figure 17A). Wherein the second part tapers to a smaller diameter away from the first part, and the second part has a length that is greater than a width of the first part, further comprising additional stabilizers positioned on the exterior of the second part (Figure 19). Further comprising a shell, an ignitable substance positioned within the shell wherein the ignitable substance propels the projectile from the shell upon ignition of the ignitable substance and a propulsion block positioned within the shell wherein the projectile is positioned within the shell adjacent the wadding and diaphragms (i.e. propulsion block) (references 308 and 305) and the ignitable substance includes primer positioned within the shell such that the primer when ignited propels the propulsion block which forces the projectile from the shell (Figure 39B and columns 49 and 50). The diaphragms may be formed of various materials such as plastic or polymer. The inhibiting substance includes capsaicin. The system further comprising a cartridge coupled with the second part wherein the cartridge includes means for launching the projectile. The system further comprising a plurality of projectiles and a means for launching the plurality of projectiles which launches at least a subset of the plurality of projectiles within a limited time to contact a target along a path across the target (columns 12 and 13). It is inherent that the first part could be reused if it could be found and the degree of frangibility is dependent on the target hit. Although Vassel et al. does not expressly disclose the projectile wherein the wadding and diaphragms are configured to maintain substantially all of a propulsion force behind the propulsion block and to evenly distribute the propulsion force to the projectile, Carbone does. Carbone teaches a projectile containing paint, or other fluid, within a shotgun cartridge. The cartridge comprising powder charge and a gas-sealing disc (reference 9) to prevent gas generated by the ignition of the powder from passing up

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or along the inner walls of the cartridge as is well known in shot gun cartridges. Carbone and Vassel et al. are analogous art because they are from the same field of endeavor: non-lethal projectile systems. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the gas sealing disc as taught by Carbone with the projectile system as taught by Vassel et al. The suggestion/motivation for doing so would have been to obtain a projectile that could have been fired using standard shot gun cartridges as is well known in the art.

### *Conclusion*

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle (Shelley) Thomson whose telephone number is 571.272.6884. The examiner can normally be reached on Monday thru Thursday 9-5.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 703.306.4198. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mrt

*Matthewson*